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Case No.: DP-306477.(7500/124)  
Serial No.: 09/997,745  
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**-- REMARKS --**

Claims 1-13 were rejected as anticipated by Kojima. This rejection is traversed. Claims 1, 5, and 9 each require that the slug is a floating slug. In contrast, the piston 48 that the Examiner likens to the claimed slug is biased by the coil spring 54. The Examiner's allegation that Kojima teaches a floating slug to the same extent as applicant's invention (page 4 of the Sept. 19, 2005 office action) is unfounded – Kojima teaches a biased piston, whereas Applicants claim a floating slug. The Examiner indicates that claims 15, 17 and 19 are rejected in the same section of the office action as the rejections of claims 1-13, but does not explicitly reject claims 15, 17, and 19 under §102, instead alleging only that Kojima "teaches wherein the slug is a floating slug to the same extent as applicant's invention." Claims 15, 17, and 19 have been cancelled, and their subject matter incorporated in claims 1, 5, and 9, obviating the rejection.

Claims 2-4, 6-8 and 10-13 depend directly or indirectly from claims 1, 5, or 9 respectively, and are therefore patentable over the prior art for at least the same reasons.

Claims 1-13 were additionally rejected as unpatentable over Ushijima in view of Aaron. This rejection is traversed. Ushijima in view of Aaron unequivocally teaches away from "a slug slidably disposed in the orifice track, the slug having a bore with a second cross-sectional area less than the first cross-sectional area" as claimed in claims 1, 5, and 9.

The Examiner's attempts to argue that Ushijima's slug 84 is the same as the claimed floating slug are erroneous. At most, Ushijima's slug 84 which is a "rotating member 84" (column 5, lines 42-46) that includes a spiral groove 84A. Ushijima's vibration isolating apparatus functions by rotating the rotating member by means of the circulation of air inside the spiral groove. Were the rotating member of Ushijima modified to include a bore, as claimed, the rotating member of Ushijima would not rotate, as the air would simply circulate through the bore, rather than through the spiral groove 84A. Thus, not only does Ushijima not disclose the claimed elements, the Examiner's

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modification would destroy the principle of operation, in contravention of the strictures of §103(a). The Examiner correctly does not cite to Aaron for such a teaching, and Aaron does not cure this defect.

The Examiner has yet to respond to Applicants' arguments about non-analogous art, and Applicants reassert the fact that the PTO classifies Ushijima and Aaron in different classes carries some weight, and serves as evidence of non-analogous art. See, *In re Ellis*, 476 F.2d 1370 (CCPA 1973).

Claims 2-4, 6-8 and 10-13 depend directly or indirectly from claims 1, 5, or 9 respectively, and are therefore patentable over the prior art for at least the same reasons.

Claim 14 was rejected as unpatentable over Kojima in view of Chikamori. This rejection is traversed. Claim 14 depends from claim 9 and is therefore allowable over the prior art for at least the same reasons.

Claim 14 was rejected as unpatentable over Ushijima in view of Aaron in view of Chikamori. This rejection is traversed. Claim 14 depends from claim 9 and is therefore allowable over the prior art for at least the same reasons.

Claim 16, 18, and 20 were rejected as unpatentable over Kojima in view of Baldini. This rejection is traversed. Claim 16, 18, and 20 depend from claims 1, 5, or 9, respectively, and are therefore allowable over the prior art for at least the same reasons.

Claim 16, 18, and 20 were rejected as unpatentable over Ushijima in view of Aaron in view of Baldini. This rejection is traversed. Claim 16, 18, and 20 depend from claims 1, 5, or 9, respectively, and are therefore allowable over the prior art for at least the same reasons.

The subject matter of claims 15, 17, and 19 has been incorporated into their respective parent claims and claims 15, 17, and 19 have been cancelled. The cancellation of these claims is not to avoid any reference, but rather to expedite prosecution, and Applicants reserve the right to present claims 1, 5, and 9 in unamended form in a continuation application.

Withdrawal of the rejections to claims 1-14, 16, 18 and 20 is requested.

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**CONCLUSION**

Reconsideration of the rejection of claims 1-20 is requested in light of the remarks herein. Applicant submits that claims 1-14, 16, 18 and 20 as set forth fully satisfy the requirements of 35 U.S.C. §§102, 103, and 112. In view of foregoing remarks, favorable consideration and early passage to issue of the present application are respectfully requested.

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Respectfully submitted,  
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